

**REMARKS**

In the last Office Action, the Examiner rejected claims 1-9, 11-19, and 21-19 under 35 U.S.C. § 102(a) as anticipated by “Java Machine Profiler Interface (JVMPI)” (i.e., Appendix A of the specification) and also rejected those claims under 35 U.S.C. § 102(f) for not being attributed to the correct inventive entity. The Examiner alleged on page 3 of the Office Action that the Declaration Under 37 C.F.R. § 1.132 filed on October 23, 2006 is insufficient to overcome the rejection of claims 1-9, 11-19, and 21-29 under 35 U.S.C. § 102(a) because only one of the inventors, Mr. Sheng Liang, has signed the Declaration. The Examiner requested that the remaining inventor, Mr. Steffen Grarup, sign a copy of the Declaration.

The Assignee of the present application, Sun Microsystems, Inc., has been unable to locate Mr. Grarup. Mr. Grarup was once an employee of the Assignee, but has since left Assignee’s employ. Assignee has made numerous attempts to locate Mr. Grarup, but has been unable to find him.

Applicants, however, respectfully request withdrawal of the rejections under 35 U.S.C. § 102(a) and (f) because Mr. Liang, the author of Appendix A of the specification, has declared that the appendix is describing the work of Mr. Liang and Mr. Grarup. *See Declaration Under 37 C.F.R. 1.132* filed on October 23, 2006. Pursuant to the M.P.E.P. and the cited case law, if the author (whether he is the applicant or not) specifically states that he is describing the work of the applicant, then there is no question of inventorship.

For example, M.P.E.P. § 2132.01 states

Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. § 102(a). *In re Katz*, 687 F.2d 450,

215 USPQ 14 (CCPA 1982) (discussed below). Therefore, where the applicant is one of the co-authors of a publication cited against his or her application, the publication may be removed as a reference by the filing of affidavits made out by the other authors establishing that the relevant portions of the publication originated with, or were obtained from, applicant. . . . The rejection can also be overcome by submission of a specific declaration by the applicant establishing that the article is describing applicant's own work. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

*In re Katz* further states

As an initial matter, we hold that authorship of an article by itself does not raise a presumption of inventorship with respect to the subject matter disclosed in the article. Thus, co-authors [or even authors] may not be presumed to be [inventors] merely from the fact of [authorship]. On the other hand, when the PTO is aware of a printed publication, which describes the subject matter of the claimed invention and is published before an application is filed . . . , the article may or may not raise a substantial question whether the applicant is the inventor. **For example, if the author (whether he is the applicant or not) specifically states that he is describing the work of the applicant, no question at all is raised.**

*In re Katz*, 687 F.2d 455 (emphasis added).

Accordingly, because Mr. Liang, the author of the Appendix A of the specification, has indicated he is describing the work of Mr. Liang and Mr. Grarup and that both of them are the inventors (see Declaration Under 37 C.F.R. 1.132 filed on October 23, 2006), there is no question of inventorship and the appendix can not be used as a reference against the present application.

### **CONCLUSION**

For at least the above reasons, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Applicants note that the Office Action contains numerous statements reflecting apparent assertions concerning the related art and claims. Regardless of whether any such statement is addressed specifically herein, Applicants decline to automatically subscribe to any assertions or characterizations set forth in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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